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MAILED

FEB 24 2011

OFFICE OF PETITIONS

In re Application of Marques	:	
Application No. 10/001,778	:	Decision on Petition
Filing Date: October 23, 2001	:	
Attorney Docket No. 97007/01C1	:	

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment of the application filed October 7, 2010, and the petition under 37 CFR 1.183 filed October 7, 2010.

The petition under 37 CFR 1.181 is **dismissed**.

The petition under 37 CFR 1.183 is **dismissed as moot**.

Any request for reconsideration of the dismissal of the petition under 37 CFR 1.181 must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

Facts

The Office mailed a non-final Office action on March 23, 2004.

An amendment and a request for a one-month extension of time were filed July 23, 2004. The amendment used the parenthetical expression "(previously added)" as the status identifier for several of the pending claims.

The Office mailed a Notice of Non-Compliant Amendment on August 6, 2004. The notice set a one-month shortened statutory period for reply. The notice indicated the July 23, 2004 amendment was non-compliant for the following reasons:

1. A paragraph adding a priority claim in the amendment was underlined,
2. A complete listing of all the claims was not present,
3. The amendment used "presently added" as a status identifier instead of "Previously presented", and
4. The amendment included a change to Claim 9 even though Claim 9 had been previously cancelled.

A request to change the address of record was filed by Attorney Robert Strozier on October 29, 2004.

Office PALM records indicate a "Miscellaneous Communication to Applicant" was mailed November 4, 2004. A copy of the November 4, 2004 communication is not located in the Image File Wrapper for the application.

Strozier filed an amendment on December 8, 2004. He indicated the amendment was being filed in "response to the 4 November 2004 Notice of Non-Compliant Amendment." The amendment included a request for a one-month extension of time. The amendment also included authorization for the Office to charge any necessary fees to Deposit Account No. 50-1518.

The December 8, 2004 amendment used the language "(previously added)" as the status identifier for several of the pending claims.

On December 21, 2004, the Office mailed a notice titled, "Failure to Acceptably Respond to Notice of Non-Compliant Amendment." The notice did not set a new time period for reply. The notice stated,

Each claim has not been provided with the proper status identifier.... [T]he status of every claim must be indicated after its claim number by using one of the following 7 status identifiers: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New) and (Not entered).

The notice also included handwritten language stating, "Previously add (sic) should read previously presented."

The examiner's objection to the use of "Previously Added" as a status identifier was based on 37 CFR 1.121(c), which stated, and continues to state,

In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

The Office did not receive a response to the December 21, 2004 notice. As a result, the Office mailed a Notice of Abandonment on February 16, 2005

The Office issued a memorandum ("Memorandum") on June 6, 2005, waiving some of the requirements in 37 CFR 1.121(c).¹ The memorandum stated,

Effective immediately, the Office is waiving certain requirements set forth in 37 CFR 1.121(c) and may accept non-compliant amendments under 37 CFR 1.121(c) where the non-compliance is limited to: 1) the inclusion of text of a canceled claim, or a not entered claim, and 2) use of certain variations of status identifiers in a claim listing....

¹ The memorandum was subsequently published in the Official Gazette. See *Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c)*, 1296 Off. Gaz. Pat. Office 27 (July 5, 2005).

[T]he Office hereby waives the provision in 37 CFR 1.121(c) that the status of the claims must be indicated by one of the status identifiers listed in 37 CFR 1.121(c) to the extent permitted in this notice.

The Office will accept claim listings that include the alternative status identifiers set forth in the following table if the amendment otherwise complies with 37 CFR 1.121.

Table of status identifiers set forth in 37 CFR 1.121(c) and acceptable alternatives

Status Identifiers Set Forth in 37 CFR 1.121(c)	Acceptable Alternatives
....	
Previously presented	Previously amended; Previously added; Previously submitted; and Previously presented claim....

The petition states,

Applicant stated Mr. Strozier did not notify him regarding the office action, that the responses were non-compliant, or of the Notice of Abandonment. Applicant stated that he learned that the patent application was abandoned on August 5, 2010 when he met with Mr. Strozier.

Applicant and current counsel have been attempting to obtain the physical prosecution file from former counsel but to date have only received electronic files of documents drafted by former counsel.

The instant petitions were filed October 7, 2010. One petition requests the withdrawal of the holding of abandonment. The other petition requests the Office consider the merits of the petition to withdraw the holding of abandonment despite a failure to comply with the two-month time limit set forth in 37 CFR 1.181(f).

The Petition Under 37 CFR 1.183

37 CFR 1.181(f) states, "Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided."

Petitioner requests the Office waive the two-month time limit in 37 CFR 1.181(f) and consider the merits of the petition to withdraw the holding of abandonment.

The use of the word "may" in 37 CFR 1.181(f) indicates the Office has the discretion to consider the merits of a petition under 37 CFR 1.181 filed more than two months after the mailing date of the action or notice from which relief is requested. In other words, it is unnecessary for the

Office to waive the time period set forth in 37 C.F.R. § 1.181(f) in order to consider the merits of the petition.

The Office has reviewed the record and, based on the current facts in the record, will exercise its discretion and consider the merits of the petition to withdraw the holding of abandonment. Therefore, the Office need not address whether or not waiver of the regulation is warranted, the petition under 37 CFR 1.183 is dismissed as moot, and the Office has scheduled a refund of the \$400 petition fee.

The Petition Under 37 CFR 1.181

The Office issued a Notice of Non-Compliant Amendment during 2004 which clearly indicated a problem existed with the status identifier for at least one claim. However, the December 8, 2004 amendment did not correct the problem. Instead, the amendment continued to use the phrase “previously added” as the status identifier for numerous claims and did not discuss, or even mention, the Office’s prior objection to the use of the phrase as a status identifier. The Office mailed a Notice of Abandonment on February 16, 2005.

The December 8, 2004 amendment failed to comply with all the requirements in the prior notice and violated 37 CFR 1.121(c) by using an improper status identifier for numerous claims. Therefore, the Office acted properly when the Office held the application abandoned and issued a Notice of Abandonment application was properly held abandoned.

The June 6, 2005 Memorandum does not seek to retroactively waive a regulation. Instead, the Memorandum clearly indicates the limited waiver set of 37 CFR 1.121 is “[e]ffective immediately.” The Memorandum was dated June 6, 2005, after the date the instant application became abandoned. Therefore, the limited waiver of 37 CFR 1.121 was inapplicable to the December 8, 2004 amendment and the application is abandoned.

Since the application is abandoned, a grantable petition under 37 CFR 1.137 must be filed if Petitioner wishes to pursue the application. The Office notes a petition under 37 CFR 1.137(b) cannot be granted unless the entire period of delay from the due date for reply until the filing of a grantable petition was unintentional. The current record fails to indicate whether or not Strozier intentionally allowed the application to go abandoned and/or intentionally failed to take actions to revive the application.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person who signed the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.²
Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney
Steven Brantley at (571) 272-3203.



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² General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.